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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,168	11/14/2003	Carlos A. Guanche	GUA002	2255
35830	7590	03/06/2006	EXAMINER	
LAWRENCE N. GINSBERG			DAWSON, GLENN K	
21 SAN ANTONIO			ART UNIT	
NEWPORT BEACH, CA 92660-9112			PAPER NUMBER	

3731

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/714,168

Applicant(s)

GUANCHE, CARLOS A.

Examiner

Glenn K. Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-40 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lenkauskas-4624672.

Lenkauskas discloses a support coil having a proximal portion 22', an intermediate portion 10 and a distal portion 20,22. The distal portion has 3 coils and ends in a straight terminal portion 22.

Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Landers-2621917.

Landers discloses a coil support having a proximal portion 10, an intermediate portion 12 and a distal portion 7 having 8 coils and a terminal straight portion 8.

Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowan-2973805.

Rowan discloses a support having a proximal portion 20, an intermediate portion 10 and a distal portion 22 having 3 coils and a straight terminal portion 24.

Claims 1-3 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hussein, et al.-5810836.

Hussein discloses a coil support having a proximal, intermediate and distal portion. Depending on the embodiment the terminal portion can be 27 or either end as shown in fig. 8D.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenkauskas-'672 in view of Taylor 5279564 and Giannuzzi-4668144.

Lenkauskas discloses the invention as claimed with the exception of the material and dimensions of the spring coil. Taylor discloses that it was known to manufacture a coil out of nitinol and Giannuzzi discloses the manufacture of a coil out of plastic. It would have been obvious to have made the coil support of Lenkauskas out of the

claimed materials, as these have been shown to be well-known coil/spring materials due to their resiliency.

As no criticality was given for the wire dimensions, they are considered nothing more than obvious design choices, as the prior art would perform equally as well as the applicant's wire.

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#### IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS

##### A. Changes in Size/Proportion

In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landers-'917 in view of Taylor 5279564 and Giannuzzi-4668144.

Landers discloses the invention as claimed with the exception of the material and dimensions of the spring coil. Taylor discloses that it was known to manufacture a coil out of nitinol and Giannuzzi discloses the manufacture of a coil out of plastic. It would have been obvious to have made the coil support of Landers out of the claimed materials, as these have been shown to be well-known coil/spring materials due to their resiliency.

As no criticality was given for the wire dimensions, they are considered nothing more than obvious design choices, as the prior art would perform equally as well as the applicant's wire.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan-805 in view of Taylor 5279564 and Giannuzzi-4668144.

Rowan discloses the invention as claimed with the exception of the material and dimensions of the spring coil. Taylor discloses that it was known to manufacture a coil out of nitinol and Giannuzzi discloses the manufacture of a coil out of plastic. It would have been obvious to have made the coil support of Rowan out of the claimed materials, as these have been shown to be well-known coil/spring materials due to their resiliency.

As no criticality was given for the wire dimensions, they are considered nothing more than obvious design choices, as the prior art would perform equally as well as the applicant's wire.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hussein, et al.-'836 in view of Taylor 5279564 and Giannuzzi-4668144.

Hussein discloses the invention as claimed with the exception of the material and dimensions of the spring coil. Taylor discloses that it was known to manufacture a coil out of nitinol and Giannuzzi discloses the manufacture of a coil out of plastic. It would have been obvious to have made the coil support of Hussein out of the claimed materials, as these have been shown to be well-known coil/spring materials due to their resiliency.

***Allowable Subject Matter***

Claims 12-40 are allowed.

***Response to Arguments***

Applicant's arguments filed 12-16-2005 have been fully considered but they are not persuasive.

Applicant argues that the 102 references are non-analogous art.

2131.05 [R-2] Nonanalogous Art

"Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). >See also *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (The question of whether a reference is analogous art is not relevant to whether

that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.).<

As for the references being non-analogous art for the 103 rejections, the examiner contends that one skilled in the art would have recognized that the applicant's invention is structurally nothing more than a wire with a coil, and would have found any art where wires and coils would be prevalent to be analogous; the structure that one would find prevalent in the classes/subclasses where the prior art was found would clearly be analogous in structure to that of applicant's invention. Therefore, the prior art is considered to be analogous art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of




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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Glenn K Dawson  
Primary Examiner  
Art Unit 3731

Gkd  
25 February 2006